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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/897,229 07/02/01 REUST

H 1177-001A

EXAMINER

HM12/1108

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YIL G

ART UNIT

PAPER NUMBER

1619

DATE MAILED:

11/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Applicant N .

09/897,229

Applicant(s)

REUST, HANSPETER

Examiner

Gina C. Yu

Art Unit

1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

P r i d f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disp sition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

Specification

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

- (a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.
- (b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.
- (c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because the process of making the invention does not enable one having ordinary skill in the art to make and use the same. The specification does not provide any specific value for the "boiling point" of whey mixture, whereas the liquid carrier for the mixture may vary. The disclosure does not reasonably enable one of ordinary skill in the art to make/use the invention especially when the boiling point of a mixture depends on the nature of the liquid carrier.

The specification lacks the support for the step of adding the preservative imidazolidinyl urea after the first cooling stage in instant claim 11 and 12. The disclosure also does not enable the skilled worker to make/use the invention because it

does not provide at what point (i.e., temperature) the first cooling stage is reached and imidazolidinyl urea should be added.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 7 and 11-13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In claim 7, the term "its boiling point", is not given a specific value in the specification. The disclosure does not reasonably enable one of ordinary skill in the art to make/use the invention especially when the boiling point of a mixture depends on the nature of the liquid carrier.

In claims 11 and 12, the specification lacks the support for cooling the mixture in two stages, and the step of adding the preservative imidazolidinyl urea after the first cooling stage is also not described. The disclosure also does not enable the skilled worker to make/use the invention because it does not provide at what point (i.e., temperature) the first cooling stage is over and imidazolidinyl urea should be added.

Claim 13 is rejected as depending on the indefinite base claim.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 is vague because it is not clear whether "about 0.1% to about 0.7 % wt. Imidazoliny l urea" is a part of the alternative limitation or a required limitation of the claim. The term "from" in line 3 is misspelled.

The term "its boiling point" in claim 7 is also vague because it is not clear which mixture in claim 3 the term refers to. There is insufficient antecedent basis for this limitation in the claim. ✓

The terms "substantially" and "fresh" in claim 13 is a relative term which renders the claim indefinite. The terms "substantially" and "fresh" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. ✓

The term "reduced" in claim 13 renders the claim indefinite because neither the claim nor the specification provides a standard for ascertaining the requisite degree of the limitation, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claims 15 and 16 provide for the process of preparing a bath powder, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually

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practiced. In this case, the claims of process for preparing a bath powder is vague and indefinite because they lack limitation as to how the process is actually carried out.

Claim 3 is also objected to because of the comma placed after "formulating" in line 5.

The remaining claims are rejected as depending on indefinite base claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-8, 10 - 14, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips et al. (U.S. Pat. No. 5,580,491) ("Phillips") in view of Costa et al. (U.S. Pat. No. 6,126,953) ("Costa") and Boothe et al. (U.S. Pat. No. 4,764,365) ("Boothe").

Phillips teaches in Example 5 a method of preparing whey-containing shaving cream composition which comprises admixing a microfiltered whey protein solution containing 5% of solids, ethanol and oil, and heating the mixture to 74 °C for 10 minutes at 2500 psi, and then cooling to 25 °C, meeting instant claim 1 and 3. Examiner views that the microfiltered whey protein isolation aqueous solution is a mixture of whey powder in a liquid carrier. The reference teaches of the mixture stored for 30 days before formulating into a shaving cream, meeting instant claim 14. Examiner also views that although the reference does not mention whether distilled or deionized water, given the

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teaching of using water in the whey solution for the use of food or cosmetic use in the reference, a skilled worker would have obviously used either type of purified water in order to eliminate the possibility of contamination, meeting instant claims 5 and 10. The reference lacks the teaching of heating the mixture between about 50 °C and its boiling point for 20-60 minutes as instant claims 7 and 8 require, however, examiner views that, given the teaching of heating the mixture at 74°C for 10 minutes, a skilled worker would have known to vary the heating temperature and time. The reference also lacks the teaching of liquid whey as in instant claim 13, however, examiner views that employing liquid whey to mix with whey powder would have been obvious to a skilled worker because of the expectation to produce a product with higher concentration of whey proteins. The reference teaches that cosmetic additives, including antimicrobial actives, may be added to the composition in conventional way, while it is silent as to the specific types of the additives. See col. 2, line 62 - col. 3, line 7.

Costa teaches various personal care compositions including body lotions, shaving creams, and shampoos. See col. 2, line 15 – col. 3, line 54. The reference teaches the preservatives, including methyl, ethyl, propyl, and butyl parabens, EDTA, and imidazolidinyl urea, may be added to the water phase of the compositions in the amount of 0.2 – 2.5 %. See col. 25, lines 8 – 12. Although the reference does not teach the specific amount of the each preservatives, examiner takes the position that a skilled worker would have discovered the optimum range of each amount by routine experiments. The reference lacks the teaching of citric acid.

Boothe teaches various personal care compositions including shaving creams and bath composition. See abstract. Example 1 in the reference teaches a method of

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preparing liquid soap which comprises adding citric acid after mixing the ingredients, heating and cooling the mixture, to adjust the pH of the solution. See col. 4, lines 17 – 61. The reference teaches to add a cationic polymer during the cooling stage, after the first stage when the mixture reaches to 50 °C, and then further cool the mixture to 45 before adding the citric acid. Although the reference lacks the teaching of the method steps of instant claims 11 and 12, examiner views that a skilled worker in the art would have known to add the additives in the solution either before or after the heating stage in order to avoid flashing off due to the high temperature.

Given the general teaching of adding cosmetic additives in the process of making cosmetic compositions containing whey in Phillips, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have to looked prior art such as Costa for specific types of the additives. The skilled worker would have been further motivated to employ citric acid to adjust the pH of the composition, as taught by Boothe.

2. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips, Costa, and Boothe as applied to claims 1-8, 10-14, and 17 above, and further in view of Japanese Patent 58192811 ("811").

The combined references, discussed above, lacks the specific method steps of instant claims 9.

'811 teaches method of preparing cosmetic composition from whey, which comprises heating whey at 30-50 degree C under a vacuum to remove the odorous constituents. See abstract.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of the combined references by reducing the pressure during the heating process, as taught by '811, because of the expectation of successfully removing odorous constituents from whey.

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-305-3593.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703-308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
November 5, 2001


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